

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division**

STEPHEN THALER,)	
)	
Plaintiff,)	
)	
vs.)	Civil Action No. 1:20cv903
)	
ANDREI IANCU,)	
in his official capacity as Under)	
Secretary of Commerce for)	
Intellectual Property & Director of)	
the United States Patent &)	
Trademark Office, <i>et al.</i> ,)	
)	
Defendants.)	
)	

ANSWER

Pursuant to Federal Rule of Civil Procedure 8, defendants, through their undersigned counsel, hereby respectfully submit the instant answer to plaintiff Stephen Thaler’s complaint in the above-captioned action.

FIRST DEFENSE

The USPTO decision at issue in this case was not arbitrary and capricious, an abuse of discretion, or otherwise not in accordance with the law.

SECOND DEFENSE

Defendants reserve the right to supplement, amend, or modify the foregoing defenses and to assert any affirmative defenses—including, but not limited to, those expressly found in Federal Rule of Civil Procedure 8(c)—that may be supported by the record.

THIRD DEFENSE

Defendants hereby respond to the numbered paragraphs of plaintiff's complaint as follows:

1. Defendants are without information sufficient to admit or deny the allegations contained within this paragraph.

2. The allegations contained within this paragraph are characterizations of the administrative record of proceedings before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

3. The allegations contained within this paragraph, to the extent they refer to a "final agency action," constitute conclusions of law to which no response is required. The remaining allegations contained within this paragraph are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

4. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

5. Defendants deny the allegations contained within this paragraph.

6. The allegations contained within this paragraph constitute either a characterization of plaintiff's complaint in this action or conclusions of law, to which no response is required.

7. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

8. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

9. Defendants are without information sufficient to admit or deny the allegations contained within this paragraph.

10. The allegations contained within this paragraph are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same. Alternatively, the allegations contained within this paragraph constitute conclusions of law, to which no response is required.

11. The allegations contained within this paragraph constitute either a characterization of plaintiff's complaint in this action or conclusions of law, to which no response is required.

12. Defendants admit the allegations contained within this paragraph.

13. Defendants are without information sufficient to admit or deny the allegations contained within this paragraph.

14. Defendants are without information sufficient to admit or deny the allegations contained within this paragraph.^{1 2}

15. The allegations contained within this paragraph are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the

¹The allegations contained within this footnote constitute only a citation to a law review article, to which no response is required.

²The allegations contained within this footnote constitute only a citation to a book, to which no response is required.

best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same. Alternatively, the allegations contained within this paragraph constitute a characterization of plaintiff's complaint, to which no response is required.

16. The allegations contained within this paragraph are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

17. The allegations contained within the first sentence of this paragraph are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.³ The allegations contained within the second and third sentences of the paragraph constitute conclusions of law, to which no response is required.

18. The allegations contained within this paragraph are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

19. The allegations contained within the first sentence of this paragraph constitute conclusions of law, to which no response is required. The remaining allegations contained within this paragraph are characterizations of the administrative record before the USPTO. The

³The allegations contained within this footnote are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

administrative record speaks for itself and is the best evidence of its contents. To the extent that the remaining allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

20. The allegations contained within the first sentence of this paragraph constitute conclusions of law, to which no response is required. The remaining allegations contained within this paragraph are characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the remaining allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

21. The allegations contained within the first sentence of this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within the first sentence of this paragraph are inconsistent with the administrative record, defendants deny the same. The allegations contained within the second sentence of this paragraph constitute conclusions of law, to which no response is required.

22. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

23. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

24. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

25. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

26. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

27. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

28. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same. To the extent that the allegation that the publication of one of the petition decisions was “unusual” is deemed factually independent from the administrative record, defendants deny that allegation.⁴

⁴The allegations contained within this footnote constitute only a citation to a web page, to which no response is required.

29. The allegations contained within the first sentence of this paragraph constitute either a statement of law, or a characterization of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same. The allegations contained within the second sentence of this paragraph constitute a conclusion of law, to which no response is required.

30. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

31. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

32. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

33. The allegations contained within this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within this paragraph are inconsistent with the administrative record, defendants deny the same.

34. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

35. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

36. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

37. The allegations contained within the first sentence of this paragraph constitute conclusions of law, to which no response is required. The allegations contained within the second sentence of this paragraph constitute a statement of policy, to which no response is required. To the extent that the allegations contained within the second sentence of this paragraph are deemed factual in nature, defendants are without information sufficient to admit or deny those allegations.

38. Defendants are without information sufficient to admit or deny the allegations contained within the first sentence of this paragraph. Defendants are without information to admit or deny the allegations contained within the second sentence of this paragraph to the extent that they allege what “as a practical matter [] may occur.” The remaining allegations contained within the second sentence of this paragraph constitute characterizations of the administrative record before the USPTO. The administrative record speaks for itself and is the best evidence of its contents. To the extent that the allegations contained within the second sentence of this paragraph are inconsistent with the administrative record, defendants deny the same. The allegations contained within the third sentence constitute a statement of law to which no response is required.⁵

⁵The allegations contained within this footnote constitute only a citation to a web page, to which no response is required.

39. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

40. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

41. The allegations contained within this paragraph constitute conclusions of law, to which no response is required. Alternatively, the allegations contained within this paragraph constitute a characterization of the cited law review article. The article speaks for itself and is the best evidence of its contents.⁶

42. The allegations contained within this paragraph constitute statements of policy, to which no response is required. To the extent that the allegations contained within this paragraph are deemed factual in nature, defendants are without information sufficient to admit or deny those allegations.

43. The allegations contained within this paragraph constitute statements of policy, to which no response is required. To the extent that the allegations contained within this paragraph are deemed factual in nature, defendants are without information sufficient to admit or deny those allegations.

44. The allegations contained within this paragraph constitute conclusions of law, to which no response is required. To the extent that the allegations contained within this paragraph are deemed factual in nature, defendants are without information sufficient to admit or deny those allegations. Alternatively, the allegations contained within this paragraph constitute a

⁶The allegations contained within this footnote constitute only a citation to a book, to which no response is required.

characterization of the cited law review article. The article speaks for itself and is the best evidence of its contents.

45. The allegations contained within this paragraph constitute statements of policy, to which no response is required. To the extent that the allegations contained within this paragraph are deemed factual in nature, defendants are without information sufficient to admit or deny those allegations. Alternatively, the allegations contained within this paragraph constitute a characterization of the cited law review article. The article speaks for itself and is the best evidence of its contents.

46. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

47. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

48. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

49. The allegations contained within this paragraph constitute conclusions of law, to which no response is required. Alternatively, the allegations contained within this paragraph constitute a characterization of the cited law review article. The article speaks for itself and is the best evidence of its contents.

50. The allegations contained within this paragraph constitute conclusions of law, to which no response is required. Alternatively, the allegations contained within this paragraph constitute a characterization of the cited treatise. The treatise speaks for itself and is the best evidence of its contents.

51. The allegations contained within the first sentence of this paragraph constitute conclusions of law, to which no response is required. The remaining allegations contained within this paragraph constitute statements of policy to which no response is required. Alternatively, the allegations contained within this paragraph constitute a characterization of the cited treatise. The treatise speaks for itself and is the best evidence of its contents.

52. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.⁷

53. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

54. The allegations contained within this paragraph constitute conclusions of law, to which no response is required.⁸

55. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

56. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

57. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

58. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

⁷The allegations contained within this footnote constitute only conclusions of law, to which no response is required.

⁸The allegations contained within this footnote constitute only conclusions of law, to which no response is required.

59. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

60. The allegations contained within the first sentence of this paragraph constitute a characterization of the cited article. The article speaks for itself and is the best evidence of its contents. The allegations contained within the second sentence of this paragraph constitute conclusions of law, to which no response is required.

61. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

62. The allegations contained within this sentence constitute conclusions of law, to which no response is required. Alternatively, the allegations constitute a characterization of the cited article. The article speaks for itself and is the best evidence of its contents.

63. The allegations contained within this sentence constitute conclusions of law, to which no response is required. Alternatively, the allegations constitute a characterization of the cited article. The article speaks for itself and is the best evidence of its contents.

64. The allegations contained within this sentence constitute conclusions of law, to which no response is required. Alternatively, the allegations constitute a characterization of the cited law review article. The law review article speaks for itself and is the best evidence of its contents.⁹

65. The allegations contained within this sentence constitute conclusions of law, to which no response is required. Alternatively, the allegations constitute a characterization of the cited law review article. The law review article speaks for itself and is the best evidence of its contents.

⁹The allegations contained within this paragraph constitute conclusions of law, to which no response is required.

66. The allegations contained within this sentence constitute conclusions of law, to which no response is required. Alternatively, the allegations constitute a characterization of the cited Commission report. The Commission report speaks for itself and is the best evidence of its contents.^{10 11}

67. Defendants re-allege and incorporate herein by reference every response contained in all of the preceding paragraphs.

68. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

69. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

70. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

71. The allegations contained within this sentence constitute conclusions of law, to which no response is required.

The remaining allegations constitute plaintiff's prayer for relief, to which no response is required.

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¹⁰The allegations contained within this paragraph constitute only a citation to a journal article, to which no response is required.

¹¹The allegations contained within this paragraph constitute only conclusions of law, to which no response is required.

Respectfully submitted,

G. ZACHARY TERWILLIGER
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DATE: November 13, 2020

ATTORNEYS FOR DEFENDANT

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Peter Sawert
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United States Patent & Trademark Office

CERTIFICATE OF SERVICE

I hereby certify that on this date, I electronically filed the foregoing with the Clerk of Court using the CM/ECF system, which will transmit a Notice of Electronic Filing (“NEF”) to the following:

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Date: November 13, 2020

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